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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,070	08/10/2001	Reinhold Schopf	DT-4067	7331
30377	7590	01/13/2004	EXAMINER	
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			GUADALUPE, YARITZA	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/928,070
Filing Date: August 10, 2001
Appellant(s): SCHOPF, REINHOLD

Alexander Zinchuck
For Appellant

EXAMINER'S ANSWER

MAILED

JAN 13 2004

GROUP 2800

This is in response to the appeal brief filed August 4, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 8 – 10 and 13 - 15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,826,372	KENDALL	5-1989
5,299,360	POSSATI	4-1994

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 8 – 10 are rejected under 35 U.S.C. 102 (b) as being anticipated by Kendall (US 4,826,372).

Kendall discloses a device including a stem (14) and a break - off region / breakneck region (24) provided in the stem consisting of a changed structure of a stem material formed along the circumference of the stem (See Figure 1) and wherein the diameter of the stem (14) at the break – off point (24), is considered substantially unchanged (See Figure 1), the area removed to create the break off region / breakneck region is so small that will not give a considerable change in the diameter of the stem. Kendall discloses said stem being metallic (See Column 13, lines 27 – 29).

2. Claims 13 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Possati et al. (US 5,299,360) in view of Kendall (US 4,826,372).

Possati et al. discloses a device having a stylus / touch probe comprising a stem (12), and a break-off region (14) provided in the stem consisting of a changed structure of a stem material. Possati et al. discloses the break – off region formed along the circumference of the stem (See Figure 1).

Possati does not disclose the diameter of the stem in the brake off region remaining substantially unchanged as stated in claim 13. Possati et al. does not disclose the stem made of a hard metal as stated in claim 15.

Regarding claims 13 and 15 : Kendall discloses a stem (14) and teaches the use of a break - off region / breakneck region (24) provided in the stem consisting of a changed structure of a stem material formed along the circumference of the stem (See Figure 1) and wherein the diameter of the stem (14) at the break – off point (24), is considered substantially unchanged, and the diameter desirable to be maximized so as to maximized the load carried by the stem (See Column 10, lines 20 – 23). Kendall further discloses said stem being metallic (See Column 13, lines 27 – 29). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the break off region disclosed by Possati et al. with a break off region / breakneck region as taught by Kendall in order to increase the capabilities of the stem by allowing maximum deformation / flexibility that allows for maximum range of motion while measuring and minimizes the range for total breakage of the stem while in use. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the stem disclosed by Possati et al. of metallic material as taught by Kendall in order to increase the life of the device by using a material of good metallurgic characteristics that provides the desired hardness for the untreated section of the stem and the desired deformation gradient on the treated region, i.e., break-off region of the stem.

(11) *Response to Argument*

INTRODUCTION

The issues in this application are whether the Kendall reference shows a break-off region consisting of a) a changed structure of a stem material. Whether Kendall shows b) the diameter of the stem at the break-off point being considered substantially unchanged. This Examiner's Answer will show that the alleged deficiencies of the Office Action are clearly disclosed by the Kendall reference.

A. With respect to the argument that Kendall does not disclose a "substantially unchanged diameter" at the break – off region of a stem material :

Appellant's argues that the breakneck / break off region of Kendall does not have the same or substantially the same diameter. Appellant's further states that the change of diameter would amount to 1% of the diameter of the stem, while Kendall discloses a 15% change in the diameter. This argument is not persuasive because the term " substantially " has not been defined in the specification. Appellant only provides one example where the change of the diameter amounts to 1% of the diameter of the stem. This example, however, does not mean that is the only possibility for a substantially unchanged diameter. Appellant should have defined or limited

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the term in the claim and the specification to a range or value, however, Appellant did not choose to do so and relies only in this one example given. In *Verve, LLC v. Crane Cams, Inc.*, the Federal Circuit vacated the District Court's summary holding of invalidity based on indefiniteness regarding the use of the term "substantially". Intrinsic evidence (specification and prosecution history) are of primary importance for interpreting claims. However, the criteria for interpreting claim language is the meaning of words as they would be understood by persons in the field of the invention. For this reason, the Examiner considers the diameter of the stem at the break-off region / breakneck region disclosed by Kendall to be "substantially unchanged", since the 15% change in the diameter in a broad sense is considered to be "substantially unchanged".

B. Regarding the changed structure of a stem material :

Appellant argues that Kendall does not show that the structure of the breakneck region has been changed. Appellant states that the changes to the claimed structure are due to the heat treatment by laser into the break – off region. The limitation "a brake off region provided in the stem and consisting of a changed structure of a stem material" could be interpreted as either a change in a physical or chemical characteristic of the stem. In this case, the change structure of a stem material has been interpreted by the Examiner to be a change in shape in the structure. Kendall, therefore, discloses a stem structure (14) that has been physically changed, i.e., the shape has been changed, so as to provide a break off region (24) that is structurally and physically different from the stem.

Appellant argues that Kendall refers to a "breakneck" and not a break-off region and that "neck" is defined by Webster's Dictionary as a "narrow portion of a structure". Appellant arguments are not persuasive. It is pointed out that "break-off" is defined by Webster's Dictionary 10th edition as "to stop abruptly". Based on this definition, a break-off region could be considered to create a larger change in the diameter along the stem, and the "breakneck" definition would better describe the substantially unchanged diameter at the region. The Kendall reference shows a portion (24) along the circumference of the stem having a narrower structure/break-neck to allow deformation/flexibility of the stem.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Diego Gutierrez
Supervisory Patent Examiner
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Appeal Conference Date :

October 16, 2003

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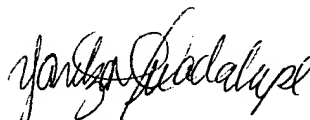
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